



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,385	12/30/1999	HENRY T. TSUEI	06042-0170	7756

7590 11/14/2006

JOHN R HARRIS
MORRIS MANNING & MARTIN LLP
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE ROAD NE
ATLANTA, GA 30326

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
----------	--------------

3694

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,385

Applicant(s)

TSUEI ET AL

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-190 is/are pending in the application.
- 4a) Of the above claim(s) 69-92 and 118-190 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-68 and 93-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 46-190 are pending in this communication filed 10/29/04 entered as Response to Election/Restriction. Applicants' have elected Group I, claims 46-68 and 93-117 with traverse. Claims 46-68 and 93-117 will be examined on the merits and the response to arguments with traverse will be addressed in the "Response to Arguments With Traverse" section of this Office Action.

Abstract

2. The abstract of the disclosure is objected to because the abstract contains over 150 words.

- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 46, 56, 61, 65, 68, 93, 94, 102, 104, 109, 114, 116, and 117 are objected to because of the following informalities: Claims 45, 65, 93, and 114 are in the improper claim format for method claims.

Claim 46 recites "In an online commerce system including a buyer computer operated by a buyer, a seller computer operated by a seller, a transaction facilitator comprising a

Art Unit: 3694

network-accessible transaction computer that facilitates commercial transactions between buyers and sellers, and at least one pre-authorized shipping service that maintains a network-accessible shipping service tracking database, a method for completing a transaction between a buyer to a seller utilizing a payment enabling system operated by a payment enabler, comprising the computer-implemented steps of: receiving transaction information from the transaction computer in response to a proposed transaction between the buyer and the seller facilitated by the ...; in response to receipt of the transaction information, communicating information to the buyer computer for displaying payment instrument selection information; receiving information from the buyer computer indicating selection of a ...; electronically requesting authorization for payment in and amount of at least ...; in response to receipt of information from the payment instrument processor ...; associating the transaction information with a tracking number associated ...; querying the shipping service tracking database based on the tracking number ...; based at least in part on information from the shipping service database indicating ...; and in response to determination that the goods have been acceptably delivered ...".

This claim would be better recited as:

"An online commerce system including a buyer computer operated by a buyer, a seller computer operated by a seller, and a transaction facilitator comprising a network-accessible transaction computer that facilitates commercial transactions between buyers and sellers, and at least one pre-authorized shipping service that maintains a network-accessible shipping service tracking database, a method for completing a

Art Unit: 3694

transaction between a buyer to a seller utilizing a payment enabling system operated by a payment enabler, comprising the computer-implemented steps of:

receiving transaction information from the transaction computer in response to a proposed transaction between the buyer and the seller facilitated by the ...;

communicating, in response to receipt of the transaction information to the buyer computer for displaying payment instrument selection information;

receiving information from the buyer computer indicating selection of a ...;

requesting, electronically authorization for payment in an amount of at least ...;

receiving in response to the information from the payment instrument processor ... to the seller computer to ship the goods by a selected pre-authorized shipping service;

associating the transaction information with a tracking number associated ... to the buyer by the shipping service;

querying the shipping service tracking database based on the tracking number ...;

indicating, based at least in part on information from the shipping service database ...

and determining if the good have been acceptably delivered ... ; and determining, in response that the goods have been acceptably delivered ...".

Claims 65, 93, and 114 have a similar problem. Claims 46, 61, 65, 93, 94, 102, 109, 114, 116, and 117 have a problem with the usage of "via". The word would be better replaced with "by" or "through".

Claim 46, page 3 recites "... delivered to the buyer, determining if the goods ...". This line would be better recited "... delivered to the buyer and determining if the goods ...".

Claims 56 and 104 recite "... flash cash, credit card". This claim limitation would be better recited "... flash cash, and credit card".

Claim 68 appears redundant by reciting "..., wherein the step of associating a tracking number associated with the shipment ...". The claim limitation would be better recited as "..., wherein the step of associating a tracking number with the shipment ...".

Appropriate correction is required.

Specification

4. The Specification is objected to because the attorney docket number at the top left side of each page needs to be removed for printing purposes. Page 22 in lines 28 and 29 in order to avoid confusion as to which figure is being discussed would be better recited "... 300. The process 300 begins ..., in which (referring to Fig. 1) between the buyer 110 and the seller 130 through the transaction facilitator 230 (Fig. 2)".

Page 23, lines 2 and 3 has a similar problem.

It is unclear from Applicants' Specification where elements "910, 930 -990, 360, and 995" are being described in the description of Figure 10. Figure 11 has the same problem with elements "910, 920, 960, 970, 980, 990, 360, and 995".

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 46 and 93 are rejected under 35 USC 112 second paragraph for the following: The preamble of claim 46 is ambiguous because it is unclear whether

Art Unit: 3694

Applicants' are claiming a system or a method. For example, the claim begins "... online commerce system including a buyer computer ..., a seller computer ..., ... a network-accessible transaction computer ..., ... a network-accessible shipping service tracking database" the recites "a method" then a system again "utilizing a payment enabling system operated by a payment enabler, comprising the computer-implemented steps of:". The body of the claim contains system throughout. For example, transaction computer, buyer computer, and seller computer" which indicate a system claim.

The preamble of a method claim should begin with "A network- accessible method for facilitating commercial transactions between buyers and sellers and at least one pre-authorized shipping service that maintains a shipping service database fro completing a transaction between a buyer to a seller utilizing a payment enabling system operated by a payment enabler, the method comprising the steps of:". Claim 93 has a similar problem.

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: before the instructions are communicated to the seller computer to ship the goods by a selected pre-authorized shipping service; there is not another step in the claim containing the "selected pre-authorized shipping service". The "selected pre-authorized shipping service" step should come before "the instructions to the seller computer to ship the goods by a pre-authorized shipping service'. A selected pre-authorization has to come first before the instructions can be given to ship the goods. After the "querying a shipping service tracking database ..."

the next step should recite "indicating based at least in part on information from querying the shipping service database based on the tracking number determining that the goods have been delivered to the buyer and determining ...;". Claim 93 has a similar problem.

Response to Arguments with Traverse

7. The following are considered to be the relevant arguments made with traverse.

Applicants' argue: Specifically, claims 46 and 69 are related as method and system counterpart (for the most part) and have the same primary limitations, yet the Examiner has separated them into Groups I and II. Similarly, claims 93 and 118 are related as method and system counterpart, yet the Examiner has separated these into Groups I and III and further still, claims 143 and 167 are related roughly as method and system counterpart but the Examiner has put them into Groups II and IV. Because the method and system counterparts have many of the same method-type limitations, logically, these should be grouped together. Response: The Examiner disagrees with this argument. Applicants' appear not to understand how a restriction is made or what makes claims restrictable. A restriction is not based on whether the claims are method or system claims. The claims are restricted as to how the claim limitations are similar to each other and whether there will be a double patenting issue if the Applicant(s) file the non-elected claims in a divisional application. Double patenting would not be an issue in the claims to this application if a divisional application were to be filed. Claims 46 and 69 do not have similar claim limitations. For example, claim 46 has receiving transaction information, receiving the information and communicating information to the

Art Unit: 3694

buyer computer, receiving information from the buyer computer, requesting authorization for payment, receiving information from the payment instrument processor, associating the transaction information, querying the shipping service tracking database, from the shipping service database indicating that the goods have been delivered to the buyer, and determining that the goods have been acceptably delivered. Where are these similar claim limitations found in claims 69, 118, 143, and 167?

The restriction is deemed proper and made final.

Allowable Subject Matter

8. Claims 46-68 and 93-117 contain allowable subject matter.
9. The following is a statement of reasons for the indication of allowable subject matter: Claims 46 and 93 reciting "querying the shipping service tracking database to determine whether the goods have been delivered to the buyer; indicating based at least in part on information from the shipping service database that the goods have been delivered to the buyer and determining if the goods have been acceptably delivered to the buyer as of an indicated delivery date; and determining in response that the goods have been acceptably delivered to the buyer as of the indicated delivery date, effecting completion of the transaction by communicating an instruction to the payment instrument processor to make payment to the seller". The dependent claims 47-68 and 94-117 are also considered allowable because of their dependency on an allowable base claim.

Claims 46-68 and 93-117 will be considered allowable once the outstanding issues have been corrected.

As allowable subject matter has been indicated, Applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 3694

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 6, 2006


ELLA COLBERT
PRIMARY EXAMINER